

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed August 7, 2006. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 4, 11 – 16, 35 – 50 are amended, claims 2 – 4, 10 – 16, and 35 – 54 remain pending, and claims 1, 5 – 9, and 17 – 34 remain cancelled. Applicants reserve the right to pursue the subject matter of the cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the cancelled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Examiner Interview**

Applicants also wish to express their sincere appreciation for the time that Examiner Ouellette spent with Applicants' Attorney, Jeffrey R. Kuester, during an in-person interview on November 27, 2006. During that interview, Examiner Ouellette explained his concerns under 35 U.S.C. §112, first paragraph, regarding the pending independent claims 11, 35, 41, and 48. Amendments made herein are designed to clarify those claims and address other matters of form. While no agreement was reached during that interview, Applicants respectfully request careful consideration of this response with amendments.

### **II. Rejections Under 35 U.S.C. §112**

The Office Action indicates that the independent claims 11, 35, 41, and 48 stand rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure that is allegedly not enabling. According to the Office Action, the above claims “disclose using licensing rights intellectual property utilization system to produce a licensing rights marketing opportunity score...” Applicants respectfully submit that the above claims do not, and did not previously, include such language, i.e., the words “utilization system” do not appear in the pending claims in their present or previous form. While Applicants submit that the claims as previously pending were allowable as written, Applicants have nonetheless amended these claims in the interest of advancing

prosecution. Accordingly, Applicants submit that the claims as currently pending should not be rejected under 35 U.S.C. §112, first paragraph.

### **III. Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 2 – 4, 11 – 13, and 35 – 50 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 6,298,327 (“*Hunter*”). Applicants traverse this rejection because *Hunter* does not disclose or render obvious determining an ***intellectual property marketing opportunity score*** for an intellectual property rights asset that is **defined and maintained as an asset** by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property rights asset. While the Office Action admits that *Hunter* fails to disclose an intellectual property marketing opportunity score, it states that *Hunter* discloses a marketability analysis and that including a marketing opportunity score would have been obvious “since the assessment would be useless without a concrete method of quantifying the results, in order to base a utilization/marketing decision.” Applicants respectfully submit that such a conclusion has no support in the reference or in logic since a quantified score is by no means necessary for a decision to utilize or market an intellectual property asset. A “go/no-go” decision can certainly be made without quantification.

Furthermore, as stated on page 177 of the present application, and now explicitly claimed, the opportunity score of one embodiment of the present application can be used for prioritization of marketing opportunities among multiple intellectual property assets. Prioritization is not referenced in *Hunter*. In addition, the marketability analysis disclosed in *Hunter* is an analysis of the marketing potential of what it refers to as the disclosed invention itself, as opposed to the marketing of an intellectual property rights asset that may be associated with what *Hunter* refers to as an invention. For example, the sale of a tangible device is very different from the sale of an intangible right associated with the device. Consequently, Applicants submit that the presently pending claims are clearly allowable.

Regarding claims 35 and 41, the Office Action admits in paragraphs 17 and 18 that *Hunter* fails to explicitly disclose wherein the criterion includes a non-royalty impact on a marketer but finds it would have been obvious to have included such a criterion because it was well known for marketing analysis to include an assessment between obtaining intellectual property protection and maintaining the intellectual property as an in-house trade secret.

Applicants respectfully disagree with this conclusion for a variety of reasons. First, trade secret protection is a well recognized form of intellectual property protection, so Applicants contend that the statement that it was well known to include an assessment between intellectual property protection and maintaining the intellectual property as an in-house trade secret is not legally possible. Second, Applicants submit that the claimed criterion of considering a non-royalty impact on a marketer due to the marketing of an intellectual property asset is very different from considering the impact of publication of an intellectual property asset because intellectual property marketing efforts are quite often confidential in nature. In fact, the sale of trade secrets must by definition be confidential in nature with regard to the specifics of the trade secrets. Consequently, Applicants respectfully contend that claims 35 and 41 are also clearly allowable for these additional reasons.

Regarding the findings of alleged nonfunctional descriptive data and Official Notice, Applicants first submit that those findings are now rendered moot. In addition, however, Applicants do not admit that any of the claimed differences are found only in nonfunctional descriptive data or are not functionally involved in the claims. Furthermore, Applicants submit that the subject matter of the Official Notice findings should not be considered well known for at least the specific and particular reason that the findings are too complex to be suitable for Official Notice. More specifically, the Office Action states that “marketing analysis of Intellectual Property was well known at the time the invention was made, to include the assessment between obtaining intellectual property protection and maintaining the intellectual property as an in-house trade secret (Coca-Cola’s maintenance of soda formulations as Trade Secrets – decision determined by analyzing long-term impact of releasing formulas to public).” This finding regarding Coca-Cola’s decision regarding its trade secret is not supported by any evidence, thus the conclusion is without support in fact. The Office Action also states that “intellectual property marketing/business assessments were well known at the time the invention was made, to include the assessment techniques/criteria disclosed in claims 36 – 38 and 42 – 45.” Notably, the Office Action does not include any factual support for this conclusion of Official Notice. Accordingly, Applicants again request valid findings of fact in support of the conclusions of alleged Official Notice or withdrawal of the conclusions.

## CONCLUSION

In conclusion, Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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